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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,522	06/04/2001	Richard E. Scordato	56154112-7	3542
26453 7590 02/04/2008 BAKER & MCKENZIE LLP 1114 AVENUE OF THE AMERICAS NEW YORK, NY 10036			EXAMINER GORDON, BRIAN R	
			ART UNIT 1797	PAPER NUMBER
			MAIL DATE 02/04/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/873,522

Applicant(s)

SCORDATO ET AL.

Examiner

Brian R. Gordon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 12-15, 18-24 and 81-83 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-8, 12-15, 18, 21-24, 81-83 is/are rejected.
- 7) ☒ Claim(s) 3, 19 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. The previous Office Action of July 24, 2007 is hereby vacated due to the ambiguity of the status indicated on the Office Action Summary. The Action was indicated as being both "Final" and "Non-Final". The appropriate correction has been made.
2. Applicant's arguments, see remarks, filed June 6, 2007, with respect to the rejection(s) of the claim(s) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Cronenberg et al. US 6,749,812.

It should be noted that claims (4-5, 12-15, 21-22, and 24) directed to the unspecified angle (theta), which has no numerical value, how one intends for the device to be held, and/or the position of the operator's hand/body are not considered further structurally limiting.

Any operator can hold the device how they choose and position their body/hand or the pipette at any angle or position they choose. The force exerted by those who choose to use the device is relative. The manner in which applicant intends for the device to be used, held, or positioned does not further limit the structure. Applicant specification states "such design should also facilitate the user's joints, including elbow, shoulder and wrist/hand being held in **their** neutral or natural position during pipetting operations,"

As implied by the passage an individual has his/her own natural position which does not change the structure of the pipette, but may change the way someone chooses to use the pipette.

As to claim 12 the angle at which one chooses to press or actuate the button is relative to the operator.

Claims 13-14 and 21 broadly recite a shape of the button and portions, respectively. However the claims do not specify any specific shape. As recited above the manner in which ones hand contacts the device is the choice of the individual. What is the specific shape or dimensions of the button/portions?

Claim 22 is directed to how one intends for the device to be held, the examiner asserts an operator can choose how the device is arranged in one's hands and furthermore control the pressure which one holds the device with. In other words, the shape of the device is not the only factor in determining how one chooses to hold the device nor determining the pressure applied thereto. The pressure exerted when a person grasps the device may vary from when another grasps the device. Furthermore depending on the individual's strength one can grasp the device how one chooses and squeeze it to apply a pressure exceeding that as recited in the claim. **An operator is not required to hold the pipette the way applicant intends for the device to be held. One can hold it with two hands or mount it in some type of stand or holder if one chooses.** If applicant is attempting to claim a specific shape of the device, it is suggested that applicant take the approach of describing the physical dimensions of the device not how a person's hand is intended to interact with the device. Applicant may

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also want to consider method claims in which applicant specifies process steps specifying how (position of hand, pressure of grasp, angle of arm, wrist, etc.) holds the device during the performance of a specific process.

As to how the device functions with a surface, it is suggested applicant amend the claims to be commensurate in scope with the arguments/remarks on page 31 to recite"....the pipette to stand on a substantially flat, horizontal surface..."

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

4. Claims 1-2, 4-5, 12-15, 18, and 21-24 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

Cronenberg et al., US 6,749,812 clearly discloses the invention claimed by applicant as disclosed there in and illustrated in figures 3A-D. The inventors of the patent are different from the inventors of the instant application.

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cronenberg et al. as applied to claims 1-2, 4-5, 12-15, 18, and 21-24 above, and further in view of Math US 2,796,204.

Math discloses the combination of a dispensing device 10 attached to a bottle 12 (bottle or bottom portion removable). As seen in the figures the device is capable of being held in one's hand and operated (via button or tab 36 substantially near the central axis) to dispense or aspirate a liquid via spout 28.

The examiner asserts that the handle element 37 may be considered a hook or the spring element 42 (as seen in the figure). The degree of the bend in the spring/hook 42 depends upon how far the tab/button 36 is depressed. The spring/hook is removable/replaceable via a screw (not labeled) and or collar 40.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of Cronenberg et al. to include a hook element such as that of Math in order to provide a means for holding and carrying the device.

***Allowable Subject Matter***

7. Claims 3 and 19-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jurecic et al. and Ruff disclose a handheld pipette.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, Telework Thurs., 1st Fri. Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian R Gordon/  
Primary Examiner  
Art Unit 1743

brg